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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,662	07/18/2000	Rufus H. Carswell	Carswell.utl	8764
21590	7590	12/16/2004	EXAMINER	
HINKLE & O'BRADOVICH, LLC 295 CULVER STREET SUITE A LAWERENCEVILLE, GA 30045			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,662

Applicant(s)

CARSWELL ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 0234.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 August 2004 has been entered.

Request for Interview

2. It is the examiner's practice to fully review applications with an RCE for allowable matter. This was deemed to be more productive than an interview before examination, so applicant's request for an interview (p. 9 of the 26 August 2004 papers) was not immediately granted. Applicant is welcome to interview this application, and may telephone the examiner at 571-272-6717 to schedule a convenient time.

Drawings

3. The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

4. Fig. 1 is missing. A new set of drawing sheets in compliance with 37 CFR 1.121(d) is required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures.

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The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Golden et al.
7. Golden et al. teaches (independent claims 1, 8 and 20) a system and method for issuing/managing promotions, and preventing fraudulent/abusive use of online promotions, the system comprising: a first computer, *service database 2* (col. 3 line 67) connected to a network (*online*, col. 3 line 61) and having a memory (storage for *coupon instructions 19*); at least one additional computer, *consumer's PC 3*, having a memory; and a first process that resides in the memory of the first computer (col. 3 line 59 to col. 4 line 8) to: distribute a promotion/*coupon* on the network; identify the downloading of the promotion by the at least one additional computer (col. 4 lines 46-51), and associate a first fraud preventative data structure, *the number of coupons to be issued*, where said number is one, with the promotion (col. 4 lines 60-65); allowing the at least one additional computer to download the promotion if security software residing on the at least one additional computer has not detected the first data structure more than once (col. 4 lines 6-8 and col. 5 lines 54-57), which also reads on terminating any further attempts by the at least one additional computer to download the promotion any additional times; associate a second fraud preventative data structure, *the consumer's PIN 50*, with the promotion and display a symbol of the data structure a *barcode of the consumer's PIN 50*, on the promotion if the promotion is printed (col. 5 lines 43-51); and communicate a copy of the second data structure to a

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clearinghouse that can compare the copy to the symbol on the promotion (col. 4 lines 46-51).

8. Applicant argues (p. 9 et seq.) that the instant invention is distinct from the invention of Golden et al., but the examiner believes that the instant claims are still drawn broadly enough to be taught by Golden et al. It was not helpful to specify that the data structures are “fraud preventing” since the examiner believes that the structures taught by Golden et al. (*the number of coupons to be issued*, where said number is one, for the first data structure, and *the consumer's PIN 50* for the second data structure) function to prevent fraud.
9. Some of applicant's arguments deal with limitations that are not claimed, which make the argument irrelevant. For example, it is correct (bottom of p. 9) that Golden's system relies on the identification of the user, but that argument is irrelevant since the claims are not limited so as to preclude reliance on the identification of the user.
10. If applicant continues to believe that the claims, as written, are distinct from the teachings of Golden et al., applicant should identify specific parts of the rejection for further explanation in an interview. For example, applicant argues (middle of the bottom para. on p. 10) that the reference does not “describe that the system identifies and terminates further attempts to download the promotions.” Yet the rejection (para. 7 above) alleges that this is taught, at col. 4 lines 6-8 and col. 5 lines 54-57. An interview would be most productive if applicant identifies beforehand (by fax to the examiner's informal number, 671-273-6717) those parts of the rejection with which applicant takes issue.
11. Interviews are appropriate to offer a proposed new amendment idea. The examiner has suggested one disclosed limitation (at para. 14-15 below) that appears to have merit.
12. Golden et al. also teaches at the citations given above claims 3-6, 18 and 19.
13. Golden et al. also teaches: claim 7, where the “device” is the *coupon issuer 1*, which accomplishes the disallowing function by downloading coupon instructions (col. 4 lines 54-55); claims 9-15 and 18, where the sites of *service database 2* (col. 2 line 48, col. 3 line 67, col. 4 lines 2-3 and col. 5 lines 64-66) reads on a web site; claims 16, where *the consumer's resident software* (col. 5 line 55) reads on a cookie; and claim 17, where the “device” is the sites of *service database 2*.

Suggestion of Allowable Subject Matter

14. The instant independent claims are presently limited to identifying the downloading of the promotion, which the examiner believes is taught by Golden et al. However, the outstanding rejection based on Golden et al. could be overcome by amending these claims to be limited to identifying the "additional computer", as disclosed at the bottom para. on p. 10.
15. Applicant is cautioned that an allowance could be considered only after this or any other amendment was searched.

Conclusion

16. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Daniel et al. (US006766301B1) is a recent related patent (but not prior art). The background discussion of Golden et al. (col. 1-3) is especially noteworthy.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
18. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER



Donald L. Champagne
Primary Examiner
Art Units 3622 (2121 detail)

9 December 2004